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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,613	12/05/2001	Paul H. Kaye	17893.006	1920

7590

07/17/2003

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EXAMINER

LABAZE, EDWYN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/010,613

Applicant(s)

KAYE ET AL.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

1. Receipt is acknowledged of preliminary amendments filed on 07/11/2002.
2. Receipt is acknowledged of IDS filed 2/19/2002.
3. Claims 28-65 are presented for examination.
4. This application claims the benefits of parent applications domestic 08/737,532 filed on 10/25/1996; 09/634,514 filed on 08/08/2000; 09/066,296 filed on 04/27/1998 and foreign PCT US95/00756 filed on 03/15/1995 and PCT GB96/02617 filed on 10/25/1996.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 28-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamir (U.S. 5,118,369).

Re claims 28, 38 and 53: Shamir discloses microlabeling system and process for making microlabeling, which includes a microparticle/micro-label 40 that is marked with a machine-readable code/bar code 46 (col.9, lines 30+), and further discloses a predetermined size of the microlabel 40 (col.5, lines 1+).

Shamir fails to disclose a thickness of 0.1 to 5.0 micrometers, a width of 0.5 to 50 micrometers and length of 0.5 to 50 micrometers.

However, Shamir suggests that the micro-label is in the micro-miniature category (col.5, lines 1+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further modify the teachings of Shamir with extra small particles including the specific range(s) in order to implement non-visible indicia/barcode that cannot be interpreted with a naked eye (e.g. increase the security of extra small/miniature items which are marked). Further such modification would be a matter of design variation to have a desirable size and could be adjusted/modified suitably to fit the appropriate application, that is to accommodate the item's/product's dimension. Furthermore, since it has been held that the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Re claims 29, 39, and 54: Shamir discloses an apparatus, wherein the microparticle 40 is formed from wafer 10 (col.8, lines 64+ and col.9, lines 53+).

Re claims 30, 40, and 55: Shamir teaches an apparatus, wherein the microparticle 40 includes silicon, silicon dioxide, or a metal (col.4, lines 42-67).

Re claims 31, 41, and 56: Shamir discloses an apparatus, wherein the microparticle 40 comprises silicon (col.4, lines 65+).

Re claims 32, 42, and 57: Shamir teaches an apparatus, wherein the microparticle 40 comprises silicon dioxide (col.4, lines 62+).

Re claims 33, 43, and 58: Shamir teaches an apparatus, wherein the microparticle 40 includes silver, aluminum 180, or gold (col.12, lines 35-67):

Re claims 34, 44, and 59: Shamir teaches an apparatus, wherein the machine-readable code/bar code 46 is readable by an optical device (col.13, lines 51+).

Re claims 35, 45, and 60: Shamir discloses an apparatus, wherein the machine-readable or bar code 46 comprises data representing more than one bit (col.3, lines 25+).

Re claims 36 and 51: Shamir discloses an apparatus, wherein the microparticle 40 has a shape/die representative of a unique code (col.3, lines 43+; col.5, lines 25+; and col.9, lines 65+).

Re claims 37, 52: Shamir teaches an apparatus, wherein the microparticle 40 defines pits, holes, or notches that represents a machine-readable code (See Figs. # 14A-B, 15, and 16 of Shamir).

Re claims 46 and 61: Shamir discloses an apparatus, wherein the compound is a gas or oxides (col.4, lines 64+).

Re claims 47 and 62: Shamir discloses an apparatus, wherein the compound is solid or thermal resistant plastic (col.4, lines 48-67).

Re claims 48 and 63: Shamir discloses an apparatus, wherein the compound is a liquid (col.4, lines 56+).

Re claims 49 and 64: Shamir teaches an apparatus, wherein the compound is paint, ink, or fluid dye (col.4, lines 56-59; col.12, lines 35+ and col.13, lines 28-50).

Re claims 50 and 65: Shamir discloses an apparatus, wherein the compound is a smoke dye (col.4, lines 4-56).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Livesay (U.S. 3,772,200) discloses method of tagging with microparticles.

Ryan et al. (U.S. 4,131,064) teaches tagging particles that are easily detected by luminescent response or magnetic pickup.

Dillon (U.S. 4,243,734) discloses micro-dot identification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
July 11, 2003

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800